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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE THE APPLICATION OF:

Inventor : Mitchell R. Swartz

Serial no. 09/ 750,765

Filed: 12/28/00

For: **METHOD AND APPARATUS
TO CONTROL ISOTOPIC FUEL
LOADED WITHIN A MATERIAL**

This is a continuation of Serial no. 07/ 760,970

Filed: 09/17/1991

PAPER:

Group Art Unit: 3641

Examiner: Mr. H. Behrend

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June 14, 2001

**Applicant's Response To
The Unsigned Communication #2**

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R E M A R K S

OFFICE OF PETITIONS

1. This is Applicant's Response to the Office's Action dated 5/11/01 (Exhibit A, attached) which is unsigned, and was not mailed until 6/06/01.
2. Applicant thanks Examiner Behrend for the apparent attention to detail and the renumbering of claims to claims 1-20 in accordance with the requirements of 37 CFR 1.121. However, Examiner Behrend's response is inconsistent with the Office's previous actions (*infra*) or those of the Federal Court. As important as those inconsistencies, Examiner Behrend's response does not comply with several of the Office's rules (also discussed below and cited previously to the Examiner).

COMMENTS ON MR. BEHREND'S SECOND "FIRST RESTRICTION"

3. Examiner Behrend has requested:

"2. This application contains claims directed to the following patentably distinct species of the claimed invention. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be patentable. Currently, no claim appears generic."

- I. The embodiment as shown in Fig. 5.
- II. The embodiment as shown in Fig. 7.
- III. The embodiment as shown in Fig. 10.
- IV. The embodiment as shown in Fig. 11.
- V. The embodiment as shown in Fig. 13.
- VI. The embodiment as shown in Fig. 15.
- VII. The embodiment as shown in Fig. 17.
- VIII. The embodiment as shown in Fig. 18.

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[Unsigned Communication From Harvey E. Behrend, 5/11/01]

Examiner Behrend's request for a new second "first-restriction" is neither necessary, nor proper, nor legal. This especially is true when viewed in the light of the original application and the Office's previous demands on the Applicant. Applicant requests reconsideration and withdrawal of the second "first-restriction" requirement for any of said following reasons.

**THERE HAS ALREADY BEEN A RESTRICTION IN 1992 BY
EXAMINER D. WASIL**

First, attention is directed to the fact that the original specification, claims and drawings of Serial no. 07/760,970 have already gone through a restriction by the Primary Examiner Daniel Wasil on June 8, 1992. This is relevant because this application is a continuation of Serial no. 07/760,970 Filed: 09/17/1991 which was already restricted by Primary Examiner Daniel Wasil after his careful, serious and previous study of the original specification and claims. Mr. Wasil separated 07/760,970 into five inventions.

For the convenience of Examiner Behrend, who has again demonstrated that he either has no access to the file records or has elected to ignore the record again, a copy of this relevant first restriction papers are yet again attached (Exhibit B).

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Attention is now directed to exactly what Examiner Wasil stated in his very careful, and very erudite examination of Serial No. 07/760970.

"Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-12, drawn to a method for controlling nuclear fusion including creating a change in the quantity of fuel, classified in Class 376, subclass 146.

II Claims 13-16, drawn to a method including the formation of composite material, classified in Class 428, subclass 548.

III. Claims 17-18, drawn to a method of controlling nuclear fusion including two orthogonal electric fields, classified in Class 376, subclass 100.

IV. Claims 19-20, drawn to a method to a method for integrating plural fusion reactors, classified in Class 376, subclass 347, (911).

V. Claims 21-24, drawn to a method to increase loading by electrochemical means and including electrodepositing, classified in Class 204, subclass 14.1"

[Communication From Daniel Wasil, Primary Examiner,

SN 07/760970, 6/8/92]

Attention is directed to the fact that Examiner Wasil already divided the claims into five (5) logical groups.

- 1) "a method for controlling nuclear fusion including creating a change in the quantity of fuel",
- 2) "a method including the formation of composite material",
- 3) "a method of controlling nuclear fusion including two orthogonal electric fields",
- 4) "a method for integrating plural fusion reactors" and
- 5) "a method to increase loading by electrochemical means and including electrodepositing".

Second, in response to Examiner Wasil's requirement that the applicant elect which invention he wished to continue prosecuting in the original application, Applicant in 1992 elected the "method for controlling nuclear fusion including creating a change in the quantity of fuel" (Exhibit C). That is what the present application is about --a continuation of the original application.

In the above-entitled application, at this time, Mr. Wasil's 1992 restriction 07/760,970 already created several inventions. Precisely pursuant to the record, Applicant notes that Mr. Wasil's assignment of what are now Claims 1-20, have been drawn to a method for controlling nuclear fusion including creating a change in the quantity of fuel. The record demonstrates that this has been concluded. The Federal Court has even concluded this.

The present new Examiner, Mr. Behrend, is again incorrect in his assignments, and obviously uncaring as to the record, or the actual application. Simply put, Applicant notes that Examiner Behrens has again shown no basis whatsoever to replace years of communications, and the long reasonable record, with his paroxysmal *de novo* and *nunc pro tunc* theory. Applicant requests reconsideration and withdrawal of the second "first-restriction" requirement.

**GIVEN THE RESTRICTION BY EXAMINER D. WASIL,
MR. BEHREND HAS NOT COMPLIED WITH 37 CFR 1.142**

5. The most important reason against this second "first-restriction" is that Examiner Behrend appears to be coercing the Applicant into double patenting for reasons not presently clear. Given the restriction by Examiner D. Wasil, Mr. Behrend's attempt at re-restriction is neither necessary nor proper in light of 37 CFR 1.142 because Mr. Behrend has not explained why, given Examiner Wasil's previous restriction, the latest restriction can support separate patents which are independent [37 CFR §1.142, (MPEP §806.04 - §806.04(j))] and [37 CFR §1.142]/or [MPEP §806.05 - §806.05(i))] distinct.

"If two or more independent and distinct inventions are claimed in a single application, the examiner shall require...his claim shall be restricted"

[Requirement for Restriction in the Code of Federal Regulations
(37 CFR §1.142), underlined for emphasis]

Thus, Mr. Behrend's restriction is improper, capricious, and constructed to force the Applicant into double patenting.

Furthermore, as the Court has found:

"Respondents' claims must be considered as a whole, it being inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis." [Diamond v. Diehr, 450 U.S. 175 (1981), 450 U.S. 175, No. 79-1112, 3/3/81]

Applicant requests reconsideration, an examination of the actual record of this case, and a withdrawal of the second "first-restriction" requirement. Once again, the Applicant requests that the Office's future response be directed to the actual application, record, and previous response by Examiner Wasil.

**GIVEN THE RESTRICTION BY EXAMINER D. WASIL,
MR. BEHREND HAS NOT COMPLIED WITH MPEP §803**

6. Examiner Behrend's request for a second "first-restriction" is neither necessary nor proper in light of MPEP §803 because given Examiner Wasil's previous restriction, there cannot be any serious burden for the examiner to examine this case on the merits.

"803 - If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. ...There must be a serious burden on the examiner if restriction is required." [underlined for emphasis]

No burden has been shown because there has already been a restriction in 1992 by Examiner Wasil after careful examination of the record. Applicant requests reconsideration and withdrawal of the second "first-restriction" requirement.

**GIVEN THE RESTRICTION BY EXAMINER D. WASIL,
MR. BEHREND HAS NOT COMPLIED WITH THE GUIDELINES**

7. Examiner Behrend's request for restriction is neither necessary nor proper in light of the Office's Guidelines because given Examiner Wasil's previous restriction, the Examiners "must provide reasons and/or examples to support (his new) conclusions".

"GUIDELINES - Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the requirement in most cases. Where plural inventions are capable of being viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement."

The Examiner has not shown that this second "first-restriction" requirement is necessary or proper, nor has the Examiner proved any reason to dispose of Mr. Wasil's reasoning. Applicant requests reconsideration and withdrawal of the second "first-restriction" requirement.

**GIVEN THE RESTRICTION BY EXAMINER D. WASIL,
MR. BEHREND IS COERCING DOUBLE PATENTING**

8. Examiner Behrend's request for restriction is neither necessary nor proper in light of MPEP §803.1 because given Examiner Wasil's previous restriction, the new Examiner's *de novo* and conflicting analysis appears to be improper and against the public interest.

"Since requirements for restriction under Title 35 U.S.C. 121 are discretionary with the Commissioner, it becomes very important that the practice under this section be carefully administered. Notwithstanding the fact that this section of the statute apparently protects the applicant against the dangers that previously might have resulted from compliance with an improper requirement for restriction, it still remains important from the standpoint of the public interest that no requirements be made which might result in the issuance of two patents for the same invention. Therefore, to guard against this possibility, the primary examiner must personally review and sign all final requirements for restriction." [803.01, Review by Primary Examiner]

It is wrong for Mr. Behrens to (again) coerce a double patenting. Applicant requests reconsideration and withdrawal of the second "first-restriction" requirement.

**GIVEN THE RESTRICTION BY EXAMINER D. WASIL,
MR. BEHREND HAS NOT COMPLIED WITH MPEP §808**

9. Examiner Behrend's request for a second "first-restriction" is neither necessary nor proper in light of MPEP §808 because given Examiner Wasil's previous restriction, the new Examiner's conflicting analysis appears to be without foundation, and without "reasons" including "the reasons for insisting upon restriction".

"Every requirement to restrict has two aspects: (1) the reasons (as distinguished from the mere statement of conclusion) why the invention as claimed are either independent or distinct, and (2) the reasons for insisting upon restriction therebetween as set forth in the following sections." [MPEP 808, Reasons for Insisting Upon Restriction]

**SUMMARY - REGARDING THE NEW
SECOND "FIRST-RESTRICTION" BY MR. BEHREND**

10. In summary, Applicant has pointed out numerous errors in Examiner Behrend's capricious action for a "second"-first restriction (supra). Applicant has also stated reasons why the restriction requirement should be withdrawn or modified with a substantive basis and explanation.

Simply put, given the previous restriction by examiner D. Wasil, Mr. Behrend's restriction by figures is improper. Examiner Behrend's request for this latest second "first-restriction" is capricious and suggests that he is systematically not responding to the record nor complying with the rules.

In addition to Mr. Behrend's latest above-cited restrictions being non-compliant, they are also inconsistent with the pleadings and case record in the Office. The record has a series of Declarations, some based upon Mr. Wasil's previous decisions. Applicant suggests that the Examiner read the record and make his statements corresponding to said record, including the past unrebutted Declarations [*In re Gazave*, 379 F.2d 973, 978, 154 USPQ 92, 96 (CCPA 1967); *In re Chilowsky*, 229 F.2d 457, 462, 108 USPQ 321, 325 (CCPA 1956); *In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980)].

Applicant requests reconsideration and withdrawal of the second "first-restriction" requirement. Applicant hereby preserves the Right of Petition.

MR. BEHREND'S ADDITIONAL RESTRICTION IS IMPROPER, INDEFINITE AND WITHOUT BASIS

11. Examiner Behrend has stated:

"3. Upon election of one of the species identified above as I-VIII, applicant is further required under 35 U.S.C. 121 to elect one of the following disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

- A. Wherein the cathode is formed of a single metal only (e.g. see the specification on page 21 and claim 2).*
- B. Wherein the cathode is formed of an alloy only (e.g. see the specification on page 22 lines 1-11).*
- C. Wherein the cathode is formed of a composite material only (as set forth in the specification on page 22 lines 17+).*
- D. Wherein the cathode metal contains tungsten microspheres (as set forth in the specification on page 23 lines 1+).*

[Unsigned Communication From Harvey E. Behrend, 5/11/01]

The Examiner's request for election of a choice of A through D is not proper for several reasons.

First, the Examiner's request for election of a choice of A through D is not indefinite. The Applicant has examined the location cited by the Examiner and does not understand the relevance. Applicant respectfully requests clarification.

Second, the Examiner's request for election of a choice of A through D is not proper at this time in light of the above-cited issues and matters because, pursuant to the Examiner, this response depends "*Upon election of one of the species identified*

above as I-VIII". Applicant necessarily is totally reliant upon the Examiner to reconsider first the Office's improper request for restriction (discussed in detail supra).

Third, the Examiner's request or election of a choice of A through D is not proper in light of MPEP §808.01(a) because there was disclosure of a relationship between many materials in the above-entitled application. This relationship overcomes the election requirement. There is no "patentable difference" with respect to the above-entitled application.

"When there is no disclosure of relationship between species, they are independent inventions and election of one invention following a requirement for restriction is mandatory even though the applicant disagrees with the examiner."

"Election of species should not be required if the species claimed are considered clearly unpatentable over each other." [MPEP §808.01(a)]

Fourth, the Examiner's request or election of a choice of A through D is not proper in light of MPEP 808.02 because the Examiner has not established any substantive reason for insisting upon his latest restriction.

"Where the related inventions as claimed are shown to be distinct...the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (A) separate classification thereof; (B) a separate status in the art when they are classifiable together; (C) a different field of search"

"Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 USC §121 is never proper. If applicant optionally restricts, double patenting may be held." [MPEP §808.02]

Therefore, Applicant has stated reasons why the requirement should be withdrawn or modified. Applicant has pointed out errors in the Examiner's action. Therefore, Applicant requests reconsideration and explicitly traverses the requirement. If the Examiner refuses reconsideration, then if necessary, applicant elects "A". Applicant hereby preserves the Right of Petition.

**MR. BEHREND'S ADDITIONAL RESTRICTION IS IMPROPER
AND WITHOUT BASIS**

12. Examiner Behrend has stated:

"4. Upon election of one of the species identified above as A-D, applicant is further required under 35 U.S.C. 121 to elect a single specie of metal and/or material of which the cathode is formed (including all materials or constituents if it is an alloy, a composite, etc.), for purposes of examination. This additional requirement is to facilitate examining due to the diverse and broad range of materials disclosed and claimed as being suitable (e.g. see claim 2 and the specification on pages 21-23)."

[Unsigned Communication From Harvey E. Behrend, 5/11/01]

The Examiner's request for election of a single specie of metal and/or material of which the cathode is formed is not proper for several reasons.

First, the Examiner's request for election of disclosed species is not proper at this time in light of the above-cited issues and matters because, pursuant to the Examiner, this response depends "*Upon election of one of the species identified above as I-VIII*". Applicant necessarily is totally reliant upon the Examiner to reconsider first the Office's improper request for restriction (discussed in detail supra).

Second, the Examiner's request or election of a single specie of metal and/or material of which the cathode is formed is not proper in light of MPEP §808.01(a) because there was disclosure of a relationship between many materials in the above-entitled application. This relationship overcomes the election requirement. There is no "patentable difference" with respect to the above-entitled application.

"When there is no disclosure of relationship between species, they are independent inventions and election of one invention following a requirement for restriction is mandatory even though the applicant disagrees with the examiner."

"Election of species should not be required if the species claimed are considered clearly unpatentable over each other." [MPEP §808.01(a)]

Third, the Examiner's request or election of a choice of A through D is not proper in light of MPEP 808.02 because the Examiner has not established any substantive reason for insisting upon his latest restriction.

"Where the related inventions as claimed are shown to be distinct...the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (A) separate classification thereof; (B) a separate status in the art when they are classifiable together; (C) a different field of search"

"Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 USC §121 is never proper. If applicant optionally restricts, double patenting may be held." [MPEP §808.02]

Therefore, Applicant has stated reasons why the requirement should be withdrawn or modified. Applicant has pointed out errors in the Examiner's action. Therefore, Applicant requests reconsideration and explicitly traverses the requirement. If the Examiner refuses reconsideration, then if necessary, applicant elects "palladium". Applicant hereby preserves the Right of Petition.

MR. BEHREND'S FURTHER RESTRICTION IS INDEFINITE, IMPROPER, AND WITHOUT BASIS

13. The Examiner has stated:

5. Upon election of one of the species identified above as A-D, applicant is further required under 35 U.S.C. 121 to elect a single specie of the number of barrier layers and of the material each barrier layer is made of. This additional requirement is to facilitate examining due to the range of barrier layers which may be present and of the materials each layer can be made of (e.g. see the specification on pages 22, 25).

[Unsigned Communication From Harvey E. Behrend, 5/11/01]

The Examiner's request for election of "a single specie of the number of barrier layers and of the material each barrier layer is made of" is not proper for several reasons, and therefore Applicant requests reconsideration and withdrawal of the request for election a "a single specie of the number of barrier layers and of the material each barrier layer is made of" for any of the following reasons.

First, this description by the Examiner is indefinite. The Applicant has examined the location cited by the Examiner and does not understand the relevance. Applicant respectfully requests clarification.

Second, the Examiner's request for election of a "a single specie of the number of barrier layers and of the material each barrier layer is made of" is not proper at this time in light of the above-cited issues and matters because, pursuant to the Examiner, this response depends "*Upon election of one of the species identified above as I-VIII*". Applicant necessarily is totally reliant upon the Examiner to first reconsider the Office's improper request for restriction (discussed in detail supra).

Third, the Examiner's request or election of a "a single specie of the number of barrier layers and of the material each barrier layer is made of" may not be proper in light of MPEP §808.01(a). Depending on what the Examiner means, there may be no "patentable difference" between said different "a single specie of the number of barrier layers and of the material each barrier layer is made of".

"Election of species should not be required if the species claimed are considered clearly unpatentable over each other." [MPEP §808.01(a)]

Fourth, the Examiner's request or election of disclosed species is not proper in light of 35 USC §121 because use of different monitoring configurations may make the inventions related, and such related inventions are not patentably distinct. Therefore the Examiner's theory of a need for restriction is not proper under 35 USC §121.

Fifth, the Examiner's request or election of a "a single specie of the number of barrier layers and of the material each barrier layer is made of" is not proper in light of MPEP 808.02 because the Examiner has not established reasons for insisting upon his latest restriction.

"Where the related inventions as claimed are shown to be distinct...the examiner, in order to establish reasons for insisting upon restriction, must sow by appropriate explanation one of the following: (A) separate classification thereof; (B) a separate status in the art when they are classifiable together; (C) a different field of search"

"Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 USC §121 is never proper. If applicant optionally restricts, double patenting may be held." [MPEP §808.02]

Applicant has stated reasons why the requirement should be withdrawn or modified. Applicant has pointed out errors and the indefiniteness in the Examiner's action. Therefore, Applicant requests reconsideration and explicitly traverses the requirement. If the Examiner refuses reconsideration, then if necessary, applicant elects the use of at least one barrier layer and the material being gold, thereby being obstructing means. Applicant hereby preserves the Right of Petition.

MR. BEHREND'S FURTHER RESTRICTION IS INDEFINITE, IMPROPER, AND WITHOUT BASIS

14. The Examiner has stated:

6. *Upon election of one of the species identified above as A-D, applicant is further required under 35 U.S.C. 121 to elect one of the following disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.*

V. Wherein the thermal conducting means consists of a thermocouple only.

W. Wherein the thermal conducting means consists only of a thermocouple connected to a diamond filament (as set forth in the specification on page 26 lines 3+).

X. Wherein the thermal conducting means consists, only of a thermocouple connected to a polymer filled with diamonds.

Y. Wherein the thermal conducting means consists, only of a diamond filament (as set forth in the specification on page 26 lines 17-21).

Z. Wherein the thermal conducting means consists, only of a polymer filled with diamonds (e.g. see claim 11).

[Unsigned Communication From Harvey E. Behrend, 5/11/01]

The Examiner's request for election of "thermal conducting means listed as choices "V" through "Z"" is not proper for several reasons, and therefore Applicant requests reconsideration and withdrawal of the request for election a "thermal conducting means listed as choices "V" through "Z" for any of the following reasons.

First, this description by the Examiner is indefinite. The Applicant has examined the location cited by the Examiner and does not understand the relevance. Applicant respectfully requests clarification.

Second, the Examiner Behrend's request is illogical. Nowhere was it stated that a thermocouple was used to thermally conduct heat because under ordinary circumstances that amount would be trivial. Mr. Behrend is deliberately confusing the issue and the case, or is confused himself.

Third, the Examiner's request for election of a "thermal conducting means listed as choices "V" through "Z is not proper at this time in light of the above-cited issues and matters because, pursuant to the Examiner, this response depends "*Upon election of one of the species identified above as I-IV*". Applicant necessarily is totally reliant upon the Examiner to first reconsider the Office's improper request for restriction (discussed in detail supra).

Fourth, the Examiner's request or election of a "thermal conducting means listed as choices "V" through "Z may not be proper in light of MPEP §808.01(a). Depending on what the Examiner means, there may be no "patentable difference" between said different "thermal conducting means listed as choices "V" through "Z.

"Election of species should not be required if the species claimed are considered clearly unpatentable over each other." [MPEP §808.01(a)]

Fifth, the Examiner's request or election of disclosed species is not proper in light of 35 USC §121 because use of different monitoring configurations may make the inventions related, and such related inventions are not patentably distinct. Therefore the Examiner's theory of a need for restriction is not proper under 35 USC §121.

Sixth, the Examiner's request or election of a "thermal conducting means listed as choices "V" through "Z is not proper in light of MPEP 808.02 because the Examiner has not established reasons for insisting upon his latest restriction.

"Where the related inventions as claimed are shown to be distinct...the examiner, in order to establish reasons for insisting upon restriction, must sow by appropriate explanation one of the following: (A) separate classification thereof; (B) a separate status in the art when they are classifiable together; (C) a different field of search"

"Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 USC §121 is never proper. If applicant optionally restricts, double patenting may be held." [MPEP §808.02]

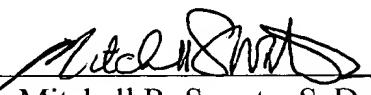
Applicant has stated reasons why the requirement should be withdrawn or modified. Applicant has pointed out errors and the indefiniteness in the Mr. Behrend's action. Therefore, Applicant requests reconsideration and explicitly traverses the requirement. If the Examiner refuses reconsideration, then if necessary, applicant elects the thermal conducting means using a thermal (heat) pipe. Applicant hereby preserves the Right of Petition.

APPLICANT FORMALLY REQUESTS SUGGESTIONS

15. Applicant requests constructive assistance and suggestions from the Examiner in drafting one or more acceptable claims [pursuant to MPEP 707.07(j)] and in making constructive suggestions [pursuant to MPEP 706.03(d)].

16. Applicant notes that the U.S. Supreme Court has ruled that any *pro se* litigant is entitled to less stringent standards [U.S. Rep volume 404, pages 520-521 (72)].

Respectfully,



Mitchell R. Swartz, ScD, MD, EE
16 Pembroke Rd., Weston, MA 02493

Certificate Of Mailing [37 CFR 1.8(a)]

To Whom it Does Concern:

I hereby certify that this correspondence will be deposited with the United States Postal Service by First Class Mail, postage prepaid, in an envelope addressed to

"The Commissioner of Patents and Trademarks
Washington, D.C. 20231" on the date below.

Thank you.
Sincerely,

June 14, 2001


M.R. Swartz